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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,147	11/25/2000	Paul Lapstun	NPS018US	4018

24011 7590 10/04/2002

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER
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KAO, CHIH CHENG G

ART UNIT	PAPER NUMBER
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2882

DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/722,147

Applicant(s)

LAPSTUN ET AL

Examiner

Chih-Cheng Glen Kao

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claim 5 is objected to because of the following informalities: Claim 5 depends upon claim 5. This objection may be obviated by changing the dependency from claim 5 to claim 4. For purposes of examination, the claim has been treated as such. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (US Patent 5995105) in view of Liddiard et al. (US Patent 5465080).

Reber et al. discloses a viewing device (Fig. 8) comprising at least one sensor for coded data and for generating first data (Fig. 8, #98), a transmitter and receiver (Fig. 8, #90 and 96) to and from a network, at least one display device which is humanly discernable (Fig. 8, #94), a printer mechanism on the substrate (Fig. 8, screen of #94), and a user interface and control (Fig. 8, #92).

However, Reber et al. does not disclose a transmitter and receiver to and from a computer system.

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Liddiard et al. teaches a transmitter and receiver to and from a computer system (col. 5, lines 1-5).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made to have the computer system of Liddiard et al. with the system of Reber et al., since a network is essentially a computer as shown by Liddiard et al. (col. 5, lines 1-5). One would be motivated to have a computer system to store memory and process information to various from other transmitters and send information out to the receivers.

3. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. in view of Liddiard et al. as applied to claim 3 above, and further in view of Wolff et al. (GB 2306669).

Reber et al. in view of Liddiard et al. suggests a system as recited above.

However, Reber et al. does not disclose the user interface with a touch sensitive overlay with the printer mechanism printing markings as the user interacts.

Wolff et al. teaches a user interface with a touch sensitive overly (Fig. 5, #10) with the printer mechanism printing markings as the user interacts (Abstract, last 2 lines).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to have the interface and feedback from the printer of Wolff et al. with the suggested system of Reber et al. in view of Liddiard et al., since one would be motivated to handle paper documents and their corresponding electronic versions simultaneously as shown by Wolff et al. (Page 1, lines 4-6) to save time.

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4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. in view of Liddiard et al. and Wolff et al. as applied to claim 5 above, and further in view of Dymetman et al. ("Intelligent Paper").

Reber et al. in view of Liddiard et al. and Wolff et al. suggests a system as recited above.

However, Reber et al. does not disclose printing on a substrate after a user has completed interaction wherein the overlay is uploaded to the computer system and the computer system downloads data based on the upload for printing on the substrate.

Dymetman et al. teaches printing on a substrate after a user has completed interaction wherein the overlay is uploaded to the computer system and the computer system downloads data based on the upload for printing on the substrate (Fig. 1, and Page 393).

It would have been obvious, to one having ordinary skill in the art at the time the invention was made, to have the completed interaction for upload and then printing on the substrate of Dymetman et al. with the suggested system of Reber et al. in view of Liddiard et al. and Wolff et al., since one would be motivated to finish a selection that is to be uploaded and then sent to the screen to see what is on the screen before moving on to another selection as implied from Wolff et al. For example, if a user clicked on 100 different points before the computer system could send to the printer mechanism to display, the computer system would be uncertain what to display, and the user will be left with unknown information.

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*Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Cheng Glen Kao whose telephone number is (703) 605-5298. The examiner can normally be reached on M - Th (8 am to 5 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Kim can be reached on (703) 305-3492. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



gk  
October 1, 2002



ROBERT H. KIM  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800